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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/516,833

02/09/2006

David Lieberman

694-11

7328

83336 7590 10/13/2010  
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EXAMINER

CRANDALL, LYNSEY P

ART UNIT

PAPER NUMBER

3769

MAIL DATE

DELIVERY MODE

10/13/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,833	<b>Applicant(s)</b> LIEBERMAN ET AL.	
	<b>Examiner</b> LYNSEY CRANDALL	<b>Art Unit</b> 3769	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 32-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 16-18, 24-26 and 36 is/are rejected.
- 7) ☒ Claim(s) 6-15, 19-23 and 27-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/2/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 1-31) in the reply filed on 8/5/2010 is acknowledged. The traversal is on the ground(s) that there is no additional search burden on the examiner to examine the claims of Group II as well. This is not found persuasive because the standard of a burdensome search is not the standard used to determine if a restriction is proper in a 371 application.
2. The requirement is still deemed proper and is therefore made FINAL. Therefore, claims 32-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Claim Objections***

3. Claims 6-15, 19-23 and 27-31 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 5, 18, 26 and 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 5 recites the limitation "the HIGH point" in line 2. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 18 recites the limitation "the HIGH point" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 26 recites the limitation "the HIGH point" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 36 recites the limitation "said shifting step" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 1 discloses a modifying step, specifically "modifying the model so as to shift points of focus to a predefined reference axis", but this is not considered a shifting step as "shifting" hasn't been positively claimed as an actual method step.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-5, 16, 18, 24, 26 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 2000/19918 to Lieberman.

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12. [Claims 1-3, 5, 24, 26 and 36] Lieberman discloses a method for improving or planning the improvement of the vision of an eye, including three different embodiments of obtaining a surface model the cornea to different degrees of accuracy. Once the model of the cornea is obtained, surface curvature is modified to achieve the degree of correction in refraction that is necessary, as determined by an eye test of the patient. The modified model of the cornea is then utilized to control the removal of material from the surface of the cornea in a corneal ablation operation (Page 7, line 31 to Page 8, line 5)

13. The third embodiment of the invention comes closest to preserving the initial shape of the cornea. Initially, a large number of angularly spaced meridians are generated on the surface model. The curves defining the meridians, which extend from the HIGH point to the periphery of the working region of the cornea are each estimated by a circular arc. Each of these arcs is then corrected in curvature to achieve the required diopter correction at the respective arc. The post-operative corneal surface is then estimated by generating a best-fit surface corresponding to all of the corrected arcs (Page 9, lines 4-14). The step of correcting the curvature of the arcs is considered modifying the model so as to shift points of focus to a predefined axis. Also, changing the curvature of the arcs, changes the radius as well.

14. [Claims 4, 16, 18] Lieberman discloses the use of a contact lens (72, Fig. 8) to correct refractive error.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 2000/19918 to Lieberman as applied to claims 16 and 25 above, and further in view of US 5,620,435 to Belkin et al.

18. Lieberman is discussed above, but is silent with regards to a specific type of lens. Belkin teaches that “the use of laser light to cut ocular tissue is also well known, particularly in extracapsular cataract extraction. Extracapsular cataract extraction is the removal of an opaque lens through the anterior segment of the eye, leaving the capsule which surrounds the lens intact. The opaque lens is replaced by an intraocular lens (IOL), usually placed inside the capsule” (Col 1, lines 46-52). Therefore it is the

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examiner's position that the method taught by Lieberman for corneal ablation can also be used to apply an intraocular lens to the eye in order as a commonly known treatment for cataracts as taught by Belkin.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYNSEY CRANDALL whose telephone number is (571)270-7035. The examiner can normally be reached on Monday to Thursday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hank Johnson can be reached on (571)272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LYNSEY CRANDALL/  
Examiner, Art Unit 3769

/Henry M. Johnson, III/  
Supervisory Patent Examiner, Art  
Unit 3769

10/7/2010